

REMARKS / ARGUMENTS

The present application includes pending claims 1-36. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable by USP 6,766,956 ("Boylan") in view of USP 5,675,647 ("Garneau"). The Applicant respectfully traverses these rejections at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to **supporting** any rejection under 35 U.S.C. 103 is the **clear articulation** of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that **the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit**. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of

ordinary skill in the art” (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Combination of Boylan and Garneau Does Not Render Claims 1-36 Unpatentable

The Applicant now turns to the rejection of claims 1-36 under 35 U.S.C. 103(a) as being unpatentable by the combination of Boylan and Garneau.

A. Rejection of Independent Claims 1, 7, 13, and 21

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Boylan and Garneau does not disclose or suggest at least the limitation of “associating, outside of the home, a plurality of key codes with a corresponding plurality of media files ...authorizing communication of one of said plurality of media files corresponding to at least one of said associated plurality of key codes, to the home, said authorizing using said associated plurality of key codes,” as recited by the Applicant in independent claim 1.

The Office Action states the following:

"Boylan teaches...associating, outside of the home, a plurality of key codes with a corresponding plurality of media files, each of said plurality of key codes corresponding to a plurality of key sequences ("codes", as defined in Col. 1 Lines 46-65, such as a **bar-code, are associated with media** from sites such as a web-site, a television distribution facility, or a data service provider, as described in Col. 2 Lines 3-64)"

See the Office Action at page 3 (emphasis added). The Examiner equates Boylan's bar-code associated with the TV programs, text, graphics, audio video media to Applicant's **"associating ...key codes with a corresponding plurality of media files,"** as recited in Applicant's claim 1. Regarding Boylan, the Examiner concedes the following:

"Boylan discloses the use of key codes for accessing promotional content communicated from a broadcast distribution facility, as described above, but does not explicitly describe **authorizing communication of one of said plurality of media files corresponding to at least one of said associated plurality of key codes, to the home, said authorizing using said associated plurality of key codes; and communicating a media file if said communication is authorized.**"

See the Office Action at page 4 (emphasis added). The Examiner concedes that Boylan's does not disclose or suggest that the same bar-code (the alleged "key codes **associated with media**"), is used **for authorizing the communication of the media**. The Examiner looks to Gameau to disclose Boylan's above deficiencies. In other words, the Examiner alleges that Gameau overcomes Boylan's deficiencies by disclosing that **the same key code, which is associated with the media** (i.e., TV programs, text, graphics, audio video media etc.), is also used **for authorizing the**

communication of the media. The Office Action states the following regarding Garneau:

"In a similar field of invention, Garneau teaches a method and system for broadcasting promotions of service available to valid subscribers, where **each promotion is associated with a specific promotion code** (Abstract). In particular, **Garneau discloses that a code entered by the subscriber is validated at Checking System 24 of Fig. 1 and, when the code is determined to be valid,** the subscriber is provided access to the promotional content (as described in Col. 7 Line 39-Col. 8 Line. Both Boylan and Garneau teach similar techniques for the distribution of promotional content in response to a user entering a corresponding access code. Boylan's system unconditionally distributes the promotional content to the user in response to the entry of the code. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Boylan to include the authorization process prior to distribution, as taught by Garneau, so that premium content or content that requires payment (i.e. pay-per view) can also be distributed to requesting users (as Garneau suggests in Col. 1 Lines 13-47), which would generate revenue for the broadcaster."

See the Office Action at page 5 (emphasis added). The Examiner seems to equate Garneau's promotion code to be the same as Boylan's bar-code, which is associated with media, such as TV programs, text, graphics, audio/video media. However, the Applicant points out that Garneau's promotion codes are **associated with services available to subscribers**. In other words, Garneau's promotion codes are not associated with the media, contrary to the allegation by the Examiner. For example, the Examiner is referred to Garneau's abstract, which states:

"This invention relates to a method of distributing signals to valid subscribers comprised of storing subscriber terminal valid identification codes at a central station. **Broadcasting promotions of services** available to subscribers, **each associated with a specific promotion**

code selecting one of the services and entering a selected service promotion code into a terminal at a subscriber location, automatically reading an identification number associated with the terminal in response to the entering of a selected promotion code, processing the identification number and the selected promotion code in accordance with an encryption algorithm and generating an encrypted event, request code therefrom, providing the event request code to a verification center at the verification center, decrypting the event request code, verifying the number against the valid identification codes and providing a password unique to the terminal and the selected promotion code, entering the password into the terminal at the subscriber location, and **providing access to a service utilizing one of the distributed signals corresponding to the selected promotion code** to the subscriber in response to the entering of the password."

See Garneau's Abstract (emphasis added). As seen in Garneau's Abstract, Garneau's promotion code is associated with providing access to a service for the subscriber, and it is not associated with the media, as alleged by the Examiner. In this regard, Garneau's promotion code is not associated with any media, and it is also not used to authorize the communication of any media. In this regard, Garneau does not overcome Boylan's deficiencies.

Based on the foregoing rationale, the Applicant maintains that the combination of Boylan and Garneau does not disclose or suggest at least the limitation of "associating, outside of the home, a plurality of key codes with a corresponding plurality of media files ...authorizing communication of one of said plurality of media files corresponding to at least one of said associated plurality of key codes, to the home, said authorizing using said associated plurality of key codes," as recited by the Applicant in independent claim

1. The Applicant respectfully requests that the rejection to claim 1 under 103(a) be withdrawn, and submits that claim 1 is allowable.

Independent claims 7, 13, and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 7, 13, and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-6 and 31-33, 8-12 and 34-36, 14-20, and 22-30

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 7, 13, and 21 under 35 U.S.C. § 103(a) as being unpatentable by the combination of Boylan and Garneau has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-6 and 31-33, 8-12 and 34-36, 14-20, and 22-30 depend from independent claims 1, 7, 13, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-36.

In general, the Final Office Action makes various statements regarding claims 1-36 and the cited reference that are now moot in light of the above. Thus, the Applicant

will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-36 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Patent Agent at (312) 775-8093.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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